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| 10/024,622 | 12/21/2001 | Daniela Giacchetti | 05725.0975-00 | 3918 |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 3629 | |

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/024,622 | GIACCHETTI ET AL. | |
| | Examiner | Art Unit | |
| | Igor Borissov | 3629 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *21 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Objections*

**Claims 32-43** are objected to because of the following informalities:

**Claim 32**. Examiner suggests to substitute a phrase "instructing *to* beauty facility" to: "instructing *the* beauty facility".

**Claims 33-38** are objected as being dependent on **claim 32.**

**Claim 39**. Examiner believes that an article "*at*" is missing in the last method sub-step after the word "subject".

**Claims 40-43** are objected as being dependent on **claim 39**.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-4, 31, 32-47 and 49-52** are rejected under 35 U.S.C. 101 because the claimed method for does not recite a limitation in the technological arts. The independently claimed steps of: *obtaining first information representative of an external body condition of a subject; obtaining second information representative of the external body condition of the subject after the subject uses a beauty product; facilitating storage of information reflecting the subject's usage of the beauty product; and enabling the subject to view the first information, the second information, and at least part of the stored information a*re abstract ideas which can be performed mentally without interaction of a physical structure. Said method steps may be understood as merely providing a sketch of a human face for getting assistance in a beauty store. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).*

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-24, 27, 29-38, 45 and 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawkins et al. (US 2002/0054714).**

Hawkins et al. (hereinafter Hawkins) teaches a method and system for evaluating cosmetic product on a consumer, comprising:

*Independent Claims.*

**Claim 1.** Capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing* of the transformed information) [0044]; displaying captured and transformed images to the user [0044].

**Claims 5, 31 and 48.** Selecting a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the

consumer [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the user [0044].

**Claim 32**. Selecting a cosmetic product and capturing an image of a body feature before and after application of the cosmetic product at a sales counter (beauty facility) [0039]; [0053]; and displaying captured and transformed images to the user [0044]. Selecting the cosmetic product at the sales counter (*beauty facility*) inherently indicates *distributing* said cosmetic product to the point of sale. Also, use of said method, disclosed by Hawkins, inherently indicates *instructing* a business entity to perform said method steps.

**Claims 49 and 50.** Selecting a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering a cosmetic product based on the results [0053].

*Dependent Claims.*

**Claims 2-3.** See **claim 1.**

**Claim 4**. Said method and system, wherein obtaining information is occurs over the Internet [0053].

**Claims 6-9**. Said method and system, wherein a cosmetic product is offered at the point-of-sale [0053].

**Claim 10**. Said method and system, wherein enabling electronic capturing of at least one of the first and second first images includes providing the beauty facility with an image capture device [0053].

**Claim 11**. Said method and system, wherein access to the image capture device is provided over the Internet [0053].

**Claim 12**. Said method and system, wherein the external body condition is a skin condition of the subject's face [0046].

**Claims 13-14.** See **claim 32.**

**Claim 15.** See **claim 5.**

**Claim 16.** See **claim 5.**

**Claim 17.** See **claim 5.**

**Claim 18.** Displaying original and transformed images side-by-side to the consumer so that the consumer forced to pick one image [0044].

**Claims 19-20**. Providing a kit for displaying a consumer's skin images, said kit including a camera and a programmable device [0026], thereby inherently indicating providing necessary software (*driver*) for the system to operate.

**Claims 21-22.** See **claim 5.**

**Claim 23**. Said method and system, wherein said cosmetic product is offered to the consumer at a retail terminal [0053]. Information as to *is the retailer a manufacturer, reseller or wholesaler* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

**Claim 24**. Displaying a consumer's skin images on a computer monitor [0026[ inherently indicates use of a *tangible recording media.*

**Claim 27.** Communications via the Internet inherently indicates viewing said images at locations remote from the beauty facility [0053].

**Claim 29.** See **claim 5.**

**Claim 30.** See **claim 27.**

**Claim 33.** Capturing images at the beauty facility [0053] inherently indicates providing "know-how" for said capturing to the beauty facility.

**Claims 34-36**. Providing a kit for displaying a consumer's skin images, including a camera and a programmable device [0026], inherently indicates providing necessary software for the system to operate.

**Claim 37.** See **claim 34.**

**Claim 38.** A cosmetic product is selected for a trial for a consumer before each image is recorded [0013]; [0014].

**Independent claim 45 is rejected under 35 U.S.C. 102(e) as being anticipated by Maloney et al. (WO 01/18674 A2).**

Maloney et al. (hereinafter Maloney) teaches a method and system for providing a customized product combination to a consumer, comprising: providing by the consumer information about consumer's cosmetic product usage and lifestyle (page 7, lines 1-2); obtaining feedback from the consumer (*update*) for the cosmetic products offered (page 12, lines 15-16); based on the collected and updated information recommending a cosmetic product to the consumer (page 12, lines 15-16).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins.**

**Claim 28**. Hawkins teaches that capturing of the consumer's first and second images may be provided either in the beauty facility, or user's home (*location remote from the beauty facility*), and that the communication between the beauty facility and the consumer may be conducted over the Internet.

However, Hawkins does not specifically teach that after the *first* image is taken in the beauty facility, the consumer *is recommended* to capture the *second* image at the *location remote from the beauty facility.*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include *recommending* the consumer to take

the second image at home, because it would be convenient for the consumer to take the second image at the time suitable for the consumer.

**Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of AS/400 Redbook Softcopy Library, an image of a CD (Document).**

**Claims 25-26**. Hawkins teaches: displaying a consumer's skin images on a computer monitor [0026], thereby inherently indicating use of a *tangible recording media.*

However, Hawkins does not teach that said tangible recording media includes a *visible marking* identifying a distributor.

Document discloses an image of a CD (which appears to be released in June, 1995), containing a *visual depiction* of a manufacturer/distributor (IBM).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include that said tangible recording media includes a *visible marking* identifying a distributor, because it would promote distributor's products.

**Claims 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Lambertsen (US 2002/0024528).**

*Independent Claim.*

**Claim 39.** Hawkins teaches all the limitations of **claim 39**, including that the consumer captures his image remotely from the beauty facility by using a digital camera (media) at home [0053].

However, Hawkins does not specifically teach that said captured image is recorded on a *transportable* media; and that the information on the transportable medium can be read by a *plurality* of beauty facilities.

Lambertsen teaches virtual makeover method and system, wherein a consumer provide his/her image on a *CD* [0038]; [0002]; and wherein said image is accessible by a *plurality* of beauty product and service providers [0031]; [0034].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include that said captured image is recorded on a *transportable* media, because it would make possible to use this method in geographical locations where network communication is not available. And It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include that said information on the transportable medium can be read by a *plurality* of beauty facilities, because it would allow the consumer to have access to variety of beauty products and services provided by different (competitive) vendors.

**Claim 44**. Hawkins teaches all the limitations of **claim 44**, including that consumer's personal information is obtained at a beauty facility; and that the consumer accesses the personal beauty information remote from the beauty facility [0053].

However, Hawkins does not specifically teach that said consumer's personal information is recorded on a *transportable* media.

Lambertsen teaches virtual makeover method and system, wherein a consumer's personal information is provided on a *CD* [0038]; [0002].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include that said captured image is recorded on a *transportable* media, because it would make possible to use this method in geographical locations where network communication is not available.

*Dependent Claims.*

**Claim 40**. Capturing the second image of the customer at home [0053] inherently indicates "updating" step at a remote location.

**Claims 41-43.** See **claim 39.**

**Claims 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2002/0077219) in view of Maloney.**

**Claim 46.** Cohen et al. (hereinafter Cohen) teaches a method and system for offering a health-related product for a consumer based on determined lifestyle, wherein price for the health-related product (exercise equipment) is determined based on estimated trend of usage of said product and lifestyle of the product users.

However, Cohen does not specifically teach that said product is a *cosmetic* product.

Maloney teaches said method and system for providing a customized *cosmetic* product combination to a consumer, wherein said cosmetic product is offered based on historical usage information of said product and lifestyle (page 7, lines 1-2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cohen to include that said product is a *cosmetic* product, because it would bring more customers to the business, thereby increase revenue.

*Dependent Claim.*

**Claim 47**. Enabling the subject to record personal information about the subject's physical characteristics, and wherein the caused at least one product recommendation is a function of the subject's lifestyle and physical information (Maloney; lines 1-2).

**Dependent claims 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Maloney.**

**Claim 51.** Hawkins teaches all the limitations of claim 51, except specifically teaching that the *consumer is enabled to maintain control through the use of software that stores the record at a location with access controlled by the consumer.*

Maloney teaches said method and system, wherein *access to the record containing personalized consumer data is enabled by entering consumer's username and password* (page 17, lines 12-13), thereby obviously indicating *controlling access* to said data.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include that *access to consumer's personal data is controlled by the consumer*, because it would enhance security of the system.

**Claim 52.** Said method and system, wherein the location is a portable information storage medium (Maloney; page 13, lines 29-30).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

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